

claims are grouped together by the Examiner with respect to this issue, and this grouping will therefore be followed below.

Telephonic Interview

A telephonic interview with the Examiner was held on September 30, 2002. The Examiner explained his position regarding the claim language that specifies "a processor programmed to read and communication only file information." The Examiner admitted that the claims were rejected under 35 USC §103 instead of 35 USC §102 because Silverbrook does not explicitly teach reading only file information. However, as noted in the Office Action and confirmed in the interview, the Examiner is giving no weight to the quoted claim language because he believes it is a functional, not structural, limitation that only states an intended use that does not differentiate the claimed apparatus from a prior art apparatus. That is, the Examiner believes that the limitation following "processor programmed" is not a structural limitation, even though he acknowledges that, whatever it may be, it is not taught in Silverbrook.

Response

The Examiner's position in the Office Action and the telephonic interview is contrary to MPEP §2106 (emphasis in bold):

Office personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. **For products, the claim limitations will define discrete physical structures or materials.** Product claims are claims that are directed to either machines, manufactures or compositions of matter. **The discrete physical structures or materials may be comprised of hardware or a combination of hardware and software.**

Accord: In re Alappat, 33 F. 3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994); *In re Warmerdam*, 33 F. 3d at 1360, 1361 n.6, 31 USPQ2d at 1759, n.6. (Fed. Cir. 1994) (emphasis in bold):

There is no requirement that a claim for a machine which incorporates process steps ... must conform to the conventional definition of a product-by-process

claim. ... Our predecessor court as recognized that **the storage of data in a memory physically alters the memory, and thus in some sense gives rise to a new memory.** See *In re Barnhart*, 417 F2d 1395, 1400, 163 USPQ 611, 616 (CCPA 1969).

It is well established that the PTO acknowledges the "processor programmed ..." limitation as proper claim language in the classification currently assigned to Silverbrook, class 345 ("Computer Graphics Processing, Operator Interface Processing, And Selective Visual Display Systems).

See, for example, claim 10 of US 6,115,026 (Spurlock) (emphasis in bold):

10. A computer system, comprising:

an installed monitor;

an installed graphics controller coupled to said installed monitor for outputting display information to said installed monitor;

a processor coupled to said graphics controller for operating said graphics controller to output display information in a format suitable for display by said installed monitor; said processor also coupled to memory;

at least one graphics driver stored by said storage device;

a monitor file and a mode file stored in said memory;

said monitor file storing information identifying the or each video mode in which each of a plurality of types of monitors can function;

said mode file storing information identifying at least the or each video mode in which each of a plurality of types of graphic controllers is operable;

wherein said processor is programmed to read said monitor file and said mode file to identify, for said graphics driver, one or more video modes in which both said installed monitor and said installed graphics controller are operable;

wherein said processor is programmed to select a said video mode identified for said graphics driver;

and wherein said processor programs said installed graphics controller with video parameters for the selected video mode of operation of said installed monitor by said graphics driver.

See also claim 22 of US 6,400,376 (Singh *et al.*) (emphasis in bold):

22. A display controller to control a touch sensitive display screen to display a virtual page that is larger than the display screen, said display controller comprising a processor programmed to:

define said virtual page as a composite of two or more subpages;

display adjacent portions of at least two of said subpages on said display screen;

identify a selected subpage by sensing a touch input in an area of said display screen where one of said subpages is displayed; and

display a predetermined portion of said selected subpage in response to said touch input.

Finally, see claim 23 of US 6,084,585 (Kraft) (emphasis in bold):

23. A data gathering system, comprising:

a digital data storage;

a video display;

one or more user input devices;

a digital data processor coupled to the video display, storage, and user input devices, the processor being programmed to provide a graphical user interface to gather data to complete a form by:

displaying on the video display a row entry template including at least one menu field and a data field corresponding to each menu field, where contents of each menu field comprise one user-selected menu entry from a predefined group of such menu entries, and each menu entry comprises a representation that a different class of information resides in the corresponding data field;

displaying a form expand selector and a submit selector on the video display;

receiving a user entry to the menu field comprising user selection of one of the predefined menu entries;

receiving a user entry to the data field comprising data entered into the data field;

detecting user activation of the form expand selector, and displaying an additional row entry template on the video display for each user activation of the expand selector; and

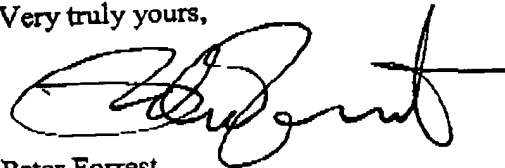
receiving user entry to the submit selector, and in response, transmitting the user entries in a machine-readable format to a predefined destination.

Thus, there simply is no basis in law or PTO practice for the Examiner's position.

The Examiner has acknowledged that Silverbrook does not teach the claimed limitation, and he has not presented any reasoning why the person of ordinary skill would be motivated to modify Silverbrook to arrive at the claimed invention. Thus, a *prima facie* case of obviousness has not been made out, and the claims should be allowed.

All other claims are dependent on the independent claims advocated above, and therefore all claims pending in the application should be allowed. Please allow the application in view of these remarks. If you have any questions, please contact me at your convenience.

Very truly yours,



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